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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,632	02/16/2000	Michael C. Scroggie	CAT/34-SCRO-CCP	5917

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NEIFELD IP LAW, PC  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER
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ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/505,632

Applicant(s)

SCROGGIE ET AL.

Examiner

Akiba K Robinson-Boyce

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M.W.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-31, 36-43 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 24-31, 36-43, 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. The following office action is in response to an amendment submitted after a decision by the Board of Patent Appeals and Interferences, which was affirmed. The following is a final office action. Claim 34 and 46 have been cancelled. Claims 50 and 51 have been added. Claims 1-24-31, 36-43 and 48-51 are pending in this application and have been examined on the merits.

### ***Claim Objections***

2. Claims 50 and 51 are objected to because of the following informalities: in the 3<sup>rd</sup> line of both claims, after "from the", the letter "a" is included and should be omitted for grammatical purposes. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 50 and 51 recites the limitation "transmission from the a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "mean for transmitting from the a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 28, 40, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 40, Sloane discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase on e of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 7, lines 13-22);

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in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 8, lines 3-7).

As per claim 50, Sloane discloses:

Transmission from the a consumer to a retailer website, (Col. 7, lines 5-10);

Transmission from the retailer website to a remote website, (Col. 7, lines 13-22), and

Transmission from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

As per claim 51, Sloane discloses:

Mean for transmitting from the a consumer to a retailer website, (Col. 7, lines 5-10);

Means for transmitting from the retailer website to a remote website, (Col. 7, lines 13-22), and

Means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, (Col. 7, lines 22-26).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35

U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:

transmitting...at least one name.../means for transmitting...at least one name...(Col. 11, lines 1-9 read with Col. 13, lines 5-10).

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the

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desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

Sloane fails to disclose the following, however Hoffinan, et al discloses: transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details.../means for transmitting from said remote site...(Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(Col. 6, lines 62-63).

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It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 9, lines 52-58, Claim 12, Claim 15).

9. Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data



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can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data...(Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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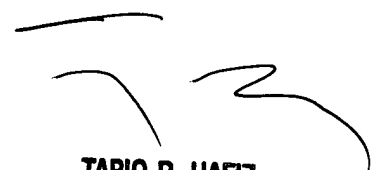
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R.-B.  
April 2, 2004



**TARIQ R. HAFIZ**  
SUPERVISORY PATENT EXAMINER  
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